

103D CONGRESS
2D SESSION

S. 2341

AN ACT

To amend chapter 30 of title 35, United States Code, to afford third parties an opportunity for greater participation in reexamination proceedings before the United States Patent and Trade-mark Office, and for other purposes.

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To amend chapter 30 of title 35, United States Code, to afford third parties an opportunity for greater participation in reexamination proceedings before the United States Patent and Trademark Office, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Patent Reexamination
5 Reform Act of 1994”.

1 **SEC. 2. DEFINITIONS.**

2 Section 100 of title 35, United States Code, is
3 amended by adding at the end thereof the following new
4 subsection:

5 “(e) The term ‘third-party requester’ means a person
6 requesting reexamination under section 302 of this title
7 who is not the patent owner.”.

8 **SEC. 3. REEXAMINATION PROCEDURES.**

9 (a) REQUEST FOR REEXAMINATION.—Section 302 of
10 title 35, United States Code, is amended to read as fol-
11 lows:

12 **“§ 302. Request for reexamination**

13 “Any person at any time may file a request for reex-
14 amination by the Office of a patent on the basis of any
15 prior art cited under the provisions of section 301 of this
16 title or on the basis of the requirements of section 112
17 of this title except for the best mode requirement. The
18 request must be in writing and must be accompanied by
19 payment of a reexamination fee established by the Com-
20 missioner of Patents and Trademarks pursuant to the pro-
21 visions of section 41 of this title. The request must set
22 forth the pertinency and manner of applying cited prior
23 art to every claim for which reexamination is requested
24 or the manner in which the patent specification or claims
25 fail to comply with the requirements of section 112 of this
26 title. Unless the requesting person is the owner of the pat-

1 ent, the Commissioner promptly will send a copy of the
2 request to the owner of record of the patent.”.

3 (b) DETERMINATION OF ISSUE BY COMMISSIONER.—
4 Section 303 of title 35, United States Code, is amended
5 to read as follows:

6 **“§ 303. Determination of issue by Commissioner**

7 “(a) Within three months following the filing of a re-
8 quest for reexamination under the provisions of section
9 302 of this title, the Commissioner will determine whether
10 a substantial new question of patentability affecting any
11 claim of the patent concerned is raised by the request,
12 with or without consideration of other patents or printed
13 publications. On his own initiative, and at any time, the
14 Commissioner may determine whether a substantial new
15 question of patentability is raised by patent or printed
16 publications or by the failure of the patent specification
17 or claims to comply with the requirements of section 112
18 of this title except for the best mode requirement.

19 “(b) A record of the Commissioner’s determination
20 under subsection (a) of this section will be placed in the
21 official file of the patent, and a copy promptly will be given
22 or mailed to the owner of record of the patent and to the
23 third-party requester, if any.

24 “(c) A determination by the Commissioner pursuant
25 to subsection (a) of this section will be final and

1 nonappealable. Upon a determination that no substantial
2 new question of patentability has been raised, the Com-
3 missioner may refund a portion of the reexamination fee
4 required under section 302 of this title.”.

5 (c) REEXAMINATION ORDER BY COMMISSIONER.—
6 Section 304 of title 35, United States Code, is amended
7 to read as follows:

8 **“§ 304. Reexamination order by Commissioner**

9 “If, in a determination made under the provisions of
10 section 303(a) of this title, the Commissioner finds that
11 a substantial new question of patentability affecting any
12 claim of a patent is raised, the determination will include
13 an order for reexamination of the patent for resolution of
14 the question. The order may be accompanied by the initial
15 Office action on the merits of the reexamination conducted
16 in accordance with section 305 of this title.”.

17 (d) CONDUCT OF REEXAMINATION PROCEEDINGS.—
18 Section 305 of title 35, United States Code, is amended
19 to read as follows:

20 **“§ 305. Conduct of reexamination proceedings**

21 “(a) Subject to subsection (b) of this section, reexam-
22 ination will be conducted according to the procedures es-
23 tablished for initial examination under the provisions of
24 sections 132 and 133 of this title. In any reexamination
25 proceeding under this chapter, the patent owner will be

1 permitted to propose any amendment to the patent and
2 a new claim or claims thereto. No proposed amended or
3 new claim enlarging the scope of the claims of the patent
4 will be permitted in a reexamination proceeding under this
5 chapter.

6 “(b)(1) This subsection shall apply to any reexamina-
7 tion proceeding in which the order for reexamination is
8 based upon a third-party reexamination request.

9 “(2) Any document (other than the reexamination re-
10 quest) filed in a reexamination proceeding by either the
11 patent owner or the third-party requester shall be served
12 on any other party.

13 “(3)(A) If the patent owner files a response to any
14 Office action on the merits, the third-party requester may
15 once file written comments within a reasonable period. At
16 a minimum, such comments may be filed within 1 month
17 after the date of service of the patent owner’s response.

18 “(B) Comments filed under this paragraph shall be
19 limited to issues covered by the Office action or the patent
20 owner’s response.

21 “(c) Unless otherwise provided by the Commissioner
22 for good cause, all reexamination proceedings under this
23 section, including any appeal to the Board of Patent Ap-
24 peals and Interferences, will be conducted with special dis-
25 patch within the Office.”.

1 (e) APPEAL.—Section 306 of title 35, United States
2 Code, is amended to read as follows:

3 **“§ 306. Appeal**

4 “(a) The patent owner involved in a reexamination
5 proceeding under this chapter may—

6 “(1) appeal under the provisions of section 134
7 of this title, and may appeal under the provisions of
8 sections 141 through 144 of this title, with respect
9 to any decision adverse to the patentability of any
10 original or proposed amended or new claim of the
11 patent; or

12 “(2) be a party to any appeal taken by a third-
13 party requester under subsection (b) of this section.

14 “(b) A third-party requester may—

15 “(1) appeal under the provisions of section 134
16 of this title, and may appeal under the provisions of
17 sections 141 through 144 of this title, with respect
18 to any final decision favorable to the patentability of
19 any original or proposed amended or new claim of
20 the patent; or

21 “(2) be a party to any appeal taken by the pat-
22 ent owner, subject to subsection (c) of this section.

23 “(c) A third-party requester who files a notice of ap-
24 peal or who participates as a party to an appeal by the
25 patent owner under the provisions of sections 141 through

1 144 of this title is estopped from later asserting, in any
2 forum, the invalidity of any claim determined to be patent-
3 able on appeal on any ground which the third-party re-
4 quester raised or could have raised during the reexamina-
5 tion proceedings. A third-party requester is deemed not
6 to have participated as a party to an appeal by the patent
7 owner unless, within twenty days after the patent owner
8 has filed notice of appeal, the third-party requester files
9 notice with the Commissioner electing to participate.”.

10 (f) REEXAMINATION PROHIBITED.—(1) Chapter 30
11 of title 35, United States Code, is amended by adding the
12 following section at the end thereof:

13 **“§ 308. Reexamination prohibited**

14 “(a) Notwithstanding any provision of this chapter,
15 once an order for reexamination of a patent has been is-
16 sued under section 304 of this title, neither the patent
17 owner nor the third-party requester, if any, nor privies of
18 either, may file a subsequent request for reexamination
19 of the patent until a reexamination certificate is issued
20 and published under section 307 of this title, unless au-
21 thorized by the Commissioner.

22 “(b) Once a final decision has been entered against
23 a party in a civil action arising in whole or in part under
24 section 1338 of title 28 that the party has not sustained
25 its burden of proving the invalidity of any patent claim

1 in suit, then neither that party nor its privies may there-
2 after request reexamination of any such patent claim on
3 the basis of issues which that party or its privies raised
4 or could have raised in such civil action, and a reexamina-
5 tion requested by that party or its privies on the basis
6 of such issues may not thereafter be maintained by the
7 Office, notwithstanding any provision of this chapter.”.

8 (2) The table of sections for chapter 30 of title 35,
9 United States Code, is amended by adding the following
10 at the end thereof:

“308. Reexamination prohibited.”.

11 **SEC. 4. CONFORMING AMENDMENTS.**

12 (a) BOARD OF PATENT APPEALS AND INTER-
13 FERENCES.—The first sentence of section 7(b) of title 35,
14 United States Code, is amended to read as follows: “The
15 Board of Patent Appeals and Interferences shall, on writ-
16 ten appeal of an applicant, or a patent owner or a third-
17 party requester in a reexamination proceeding, review ad-
18 verse decisions of examiners upon applications for patents
19 and decisions of examiners in reexamination proceedings,
20 and shall determine priority and patentability of invention
21 in interferences declared under section 135(a) of this
22 title.”.

23 (b) PATENT FEES; PATENT AND TRADEMARK
24 SEARCH SYSTEMS.—Section 41(a)(7) of title 35, United
25 States Code, is amended by inserting “or for an uninten-

tionally delayed response by the patent owner in a reexamination proceeding,” after “issuing each patent,”.

(c) APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES.—Section 134 of title 35, United States Code, is amended to read as follows:

“§ 134. Appeal to the Board of Patent Appeals and Interferences

“(a) An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

“(b) A patent owner in a reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

“(c) A third-party requester may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.”.

(d) APPEAL TO COURT OF APPEALS FOR THE FEDERAL CIRCUIT.—Section 141 of title 35, United States Code, is amended by amending the first sentence to read as follows: “An applicant, a patent owner or a third-party requester, dissatisfied with the final decision in an appeal

1 to the Board of Patent Appeals and Interferences under
2 section 134 of this title, may appeal the decision to the
3 United States Court of Appeals for the Federal Circuit.”.

4 (e) PROCEEDINGS ON APPEAL.—Section 143 of title
5 35, United States Code, is amended by amending the third
6 sentence to read as follows: “In ex parte and reexamina-
7 tion cases, the Commissioner shall submit to the court in
8 writing the grounds for the decision of the Patent and
9 Trademark Office, addressing all the issues involved in the
10 appeal.”.

11 (f) CIVIL ACTION TO OBTAIN PATENT.—Section 145
12 of title 35, United States Code, is amended in the first
13 sentence by inserting “(a)” after “section 134”.

14 **SEC. 5. EFFECTIVE DATES.**

15 This Act shall take effect six months after the date
16 of enactment of this Act and shall apply to all reexamina-
17 tion requests filed on or after such date.

Passed the Senate October 4 (legislative day, Sep-
tember 12), 1994.

Attest:

Secretary.